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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,233	01/20/2004	Yoshiumi Hamada	46238	6456
1609	7590	07/06/2006	EXAMINER	
ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P. 1300 19TH STREET, N.W. SUITE 600 WASHINGTON,, DC 20036			BRUENJES, CHRISTOPHER P	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/759,233

Applicant(s)

HAMADA, YOSHIUMI

Examiner

Christopher P. Bruenjes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-22 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) 13-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-12,22 and 24-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

**WITHDRAWN REJECTIONS**

1. The claim objection and 35 U.S.C. 112 rejections of claims 1-12 and 22-25 of record in the Office Action mailed January 10, 2006, Pages 3-5 Paragraphs 3-4, have been withdrawn due to Applicant's amendments in the Paper filed May 10, 2006.

2. The 35 U.S.C. 102 rejections of claims 1-4 and 6-12 as anticipated by Wysocki of record in the Office Action mailed January 10, 2006, Pages 5-7 Paragraph 5, have been withdrawn due to Applicant's amendments in the Paper filed May 10, 2006.

3. The 35 U.S.C. 103 rejections of claims 1-8, 10-11, 22-24 over Bara in view of Wysocki of record in the Office Action mailed January 10, 2006, Pages 8-11 Paragraph 6, have been withdrawn due to Applicant's amendments in the Paper filed May 10, 2006.

4. The 35 U.S.C. 103 rejections of claims 1-12 and 22-25 over Ganguly in view of Bara and Wysocki of record in the Office Action mailed January 10, 2006, Pages 12-16 Paragraph 7, have

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been withdrawn due to Applicant's amendments and the 37 C.F.R.

1.131 Declaration filed May 10, 2006.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-4, 6-7, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberthur et al (USPN 6,369,042) in view of Wysocki (USPN 4,261,462).

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Regarding claims 1 and 22, Oberthur et al teach a composition, which comprises a coloring agent (col.15, 1.65 - col.16, 1.1), a cosmetic (col.16, 1.11-29), an organic solvent, and water (col.16, 1.3-10). Furthermore, the composition is formed as an aerosol and placed in a container such as a can to be sprayed on to the skin by utilizing a propellant in the composition (col.16, 1.30-41).

Oberthur et al fail to teach that the container housing the composition further includes an illustrative medium made up of descriptive text and/or images. However, Wysocki teach that it is well known in the art to provide illustrative mediums in the form of labels directly to a container for cosmetic preparations and also directly printed on outer packaging of bottles containing cosmetic preparations in order to provide information and directions on use of the contained cosmetic. In particular, the direct printing on the outer package teaches the limitations of claim 2, and the label teaches the limitations of claims 3-4. Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made that the two references are analogous insofar as both references are concerned the packaging of cosmetics, and that illustrative text and/or images are applied to containers for cosmetics as well as outer packaging for the same, in order to provide the user of

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the cosmetic with information and directions, as taught by Wysocki.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to add illustrative text and/or images as taught by Wysocki to the cosmetic container of Bara in the form of a label and/or outer packaging in order to provide the user of the cosmetic with information and directions, as taught by Wysocki.

Note that the limitation that the illustrative medium "informs users that a stocking-like layer is formed by directly spray-jetting the above coloring agent along with the cosmetic on stocking-less legs" is a limitation directed at non-functional printed matter. Nonfunctional printed matter does not distinguish a claimed product from an otherwise identical prior art product because where the printed matter is not functionally related to the substrate; the printed matter will not distinguish the invention from the prior art in terms of patentability. The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See MPEP 2112.01 III. In this case, Wysocki teach illustrative text and/or images on the container and outer package even though the content of the text and/or images may be different from the claimed invention.

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Regarding claims 6-7, Oberthur et al teach the coloring agent is an organic pigment (col.4, 1.19-25) and is included in an amount of 0.15% by weight based on the weight of the composition (col.10, 1.29-33 and col.16, 1.1-2).

8. Claims 8-12 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberthur et al in view of Wysocki as applied to claims 1 and 22 above, and further in view of Canter et al (USPN 6,060,547).

Regarding claims 8-12 and 24 and 26, Oberthur et al and Wysocki teach all that is claimed in claims 1 and 22 as presented above, and Oberthur et al teach that the coloring agent formed of the analog has its color influenced by the addition of other pigments, but fails to teach what the other pigments are that are added to the cosmetic composition. However, Canter et al teach coloring agents well known in the art of cosmetic compositions include pearling agents, which form pearly lusters, titanium oxide, silk powder, zinc oxide, iron oxide, ultramarine, mica, and silica (col.8, 1.25-39). Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to select pigments to influence color in a cosmetic composition from known pigments used for that purpose.

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Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to select the coloring agent pigment added to the cosmetic composition of Oberthur et al in order to influence the color from the known pigments described in Canter et al, since Canter et al teach that those particular pigments are known in the art and one of ordinary skill in the art would obviously select additional pigments from known pigments for that purpose.

Regarding claims 12 and 25, Oberthur et al and Wysocki teach all that is claimed in claims 1 and 22 as presented above, but fail to explicitly teach that the cosmetic composition includes a film forming polymer. However, Canter et al teach that film forming polymers are added to skin cosmetics in order to provide better looking, longer lasting benefits compared to conventional skin cosmetics (col.2, 1.42-47). Canter et al teach that film forming polymers are added to a cosmetic composition in the amount between 0.5% and 10% in order to provide superior feel, look and wear characteristics to the cosmetic composition (col.4, 1.1-10). Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to add a film forming polymer in an amount between 0.5% and 10% to a cosmetic composition in



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order to provide the composition with enhanced feel, look, and wear characteristics, as taught by Canter et al.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to add a film forming polymer in an amount between 0.5% and 10% to the cosmetic composition of Oberthur et al in order to provide the cosmetic composition with enhanced feel, look, and wear characteristics, as taught by Canter et al.

#### ***Response to Amendment***

9. The declaration filed on May 10, 2006 under 37 CFR 1.131 is sufficient to overcome the Ganguly et al reference.

#### ***Response to Arguments***

10. Applicant's arguments with respect to claims 1-4, 6-12, 22, and 24-26 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nakanishi (US 2002/0131947 A1) teaches a multitude of coloring agents that are well known to be used in forming cosmetics, see especially page

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6, paragraphs 83-88. Patil et al (USPN 6,342,209) teaches adding a film-forming polymer to a cosmetic composition.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher P Bruenjes  
Examiner

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*CPB*  
CPB

June 29, 2006

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER

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*6/30/06*